

ESTTA Tracking number: **ESTTA745854**

Filing date: **05/11/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Port Authority of New York and New Jersey
Granted to Date of previous extension	05/11/2016
Address	4 World Trade Center, 23rd Floor 150 Greenwich Street New York, NY 10007 UNITED STATES

Attorney information	Michael Geller DLA Piper LLP 203 North LaSalle Street, Suite 1900 Chicago, IL 60601 UNITED STATES leon.medzhibovski@dlapiper.com, keith.medansky@dlapiper.com, michael.geller@dlapiper.com, ch.tm@dlapiper.com Phone:312-368-4000
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Applicant Information

Application No	86570267	Publication date	01/12/2016
Opposition Filing Date	05/11/2016	Opposition Period Ends	05/11/2016
Applicant	World Trade Centers Association, Inc. 120 Broadway, Suite 3350 New York, NY 10271 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 035. First Use: 1985/10/01 First Use In Commerce: 1987/02/02 All goods and services in the class are opposed, namely: Analysis of market research data and statistics; Arranging and conducting special events for commercial, promotional, business or advertising purposes; Business consultation in the field of international trade; Business research; Compiling and analyzing statistics, data and other sources of information for business purposes; Conducting, arranging, organizing and promoting trade shows and trade fairs for commercial, economic or advertising purposes; Economic information, forecasting and analysis; Foreign trade information and consultation; International business consulting services relating to foreign trade; Market reports and studies; Organization of events, exhibitions, fairs and shows for commercial, promotional, business and advertising purposes; Planning and conducting of trade fairs, shows exhibitions and presentations for economic or advertising purposes; Promoting commercial, trade and other business relationships between the United States and foreign nations; Promoting economic development in the member regions of the U.S.; Providing business information via a website; Providing facilities for trade exhibitions; Providing marketing and promotion of special events; Referrals in the field of foreign trade; Trade information</p>
<p>Class 041. First Use: 1985/10/01 First Use In Commerce: 1987/02/02 All goods and services in the class are opposed, namely: Educational services, namely, providing dis-</p>

plays and exhibits in the field of international business and trade; Organization of seminars; Providing education, namely, seminars and workshops in the field of international business and trade; Providing online newsletters in the field of international business and trade via e-mail; Publication of brochures; Publication of reports; Workshops and seminars in the field of international business and trade
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Grounds for Opposition

Other	The grounds are stated in the pleading for the notice of opposition.
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Attachments	Notice of Opposition - 267.pdf(296695 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Michael Geller/
Name	Michael Geller
Date	05/11/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Serial No. 86/570,267
Mark: WTC MIAMI
Filed: March 19, 2015
Published: January 12, 2016

THE PORT AUTHORITY OF NEW YORK AND)	
NEW JERSEY)	
)
Opposer,)	
)
v.)	Opposition No.:
)
WORLD TRADE CENTERS ASSOCIATION,)	
INC.)	
)
Applicant.)	

NOTICE OF OPPOSITION

THE PORT AUTHORITY OF NEW YORK AND NEW JERSEY, a body corporate and politic created by a compact between the states of New York and New Jersey with the consent of the United States Congress, located at 4 World Trade Center, 150 Greenwich Street, 23rd Floor, New York, New York 10007 (hereinafter "Opposer"), believes that it would be damaged by registration of the mark shown in Application Serial No. 86/570,267 (hereinafter "the Application"), filed March 19, 2015 by World Trade Centers Association, Inc. (hereinafter "Applicant"), published in the Official Gazette of the United States Patent and Trademark Office (hereinafter the "USPTO") on January 12, 2016, and hereby opposes the registration of such mark.

The grounds for the opposition are as follows:

1. Opposer is a body corporate and politic created in 1921 that manages various areas, elements of infrastructure and methods of transportation including, but not limited to, bridges, tunnels, airports and transit in New York City and Northern New Jersey.

2. In 1962, Opposer was granted the statutory right and obligation by the states of New York and New Jersey to develop and manage an area in downtown New York City, which the statutes named the World Trade Center. N.Y. Unconsol. § 6602 (McKinney 2006); N.J. Stat. Ann. § 32:1-35.51 (2006).

3. The World Trade Center was home to the “Twin Towers,” which were destroyed in the September 11, 2001 terrorist attacks, and now features the building named “One World Trade Center,” among other buildings, monuments and transportation facilities (collectively, the “Site”).

4. In or around 1961, Opposer adopted and began using the trademark WORLD TRADE CENTER in connection with its services offered at the Site. Subsequently, Opposer adopted and began using the trademark WTC as an acronym for the WORLD TRADE CENTER mark in connection with its products and services offered at the Site.

5. In 1986, Opposer allegedly assigned certain, but not all, of its rights in and under the service mark WORLD TRADE CENTER in connection *only* with certain services to Applicant (the “’86 Assignment”). The ’86 Assignment is attached hereto as **Annex A**.

6. The propriety, validity and scope of the ’86 Assignment has recently come into question.

7. Opposer did not assign any of its rights, title, interest or goodwill to the WTC trademarks in connection with the services claimed in the Application. *See Annex A*.

8. Therefore, Opposer, not Applicant, is the owner of the WTC trademarks in connection with the services claimed in the Application.

9. The grant of a registration to Applicant for the WTC MIAMI mark as sought in the Application (hereinafter “Applicant’s Mark”) should be denied because Opposer is the owner of the WTC trademarks in connection with the services claimed in the Application. Applicant’s Mark fully incorporates Opposer’s WTC trademark as well as the geographically descriptive term MIAMI and covers identical services as Opposer’s WTC trademark. Granting registration to Applicant for Applicant’s Mark will disrupt Opposer’s statutory right to exclusive use and control of the WTC trademark, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

10. Alternatively, Opposer asserts that the grant of registration to Applicant for Applicant’s Mark should be denied in light of Opposer’s prior common law rights.

11. Alternatively, Opposer asserts that the ’86 Assignment was improper, invalid and/or otherwise incomplete based on, without limitation, Applicant and its representatives’ self-dealing and conflicts of interest.

12. Alternatively, Opposer asserts that granting registration to Applicant for Applicant’s Mark will deprive Opposer the right to use the WTC mark in connection with the services claimed in the Application, in derogation of the statutory mandate obligating Opposer to manage and operate the World Trade Center site.

13. Applicant filed a federal complaint against Opposer regarding Opposer’s use of the WORLD TRADE CENTER and WTC trademarks (the “Litigation”). The Litigation will

determine the outcome of, and substantially bears on, this opposition and, therefore, Opposer, in a separate filing, requests a suspension of this opposition.

WHEREFORE, Opposer files this Notice of Opposition and prays that the aforesaid application of World Trade Centers Association, Inc., herein opposed, be rejected; that no registration be issued thereon to Applicant; and for such other and further relief as may be deemed just and proper.

The Deposit Account No. 18-2284 should be charged the amount of \$300.00 to cover the filing fees of this notice of opposition against the Application. Please charge any additional fees to Deposit Account No. 18-2284, and address all correspondence regarding this opposition to:

Dated: May 11, 2016

Respectfully submitted,

**THE PORT AUTHORITY OF NEW YORK
AND NEW JERSEY**

By: /s/ Michael A. Geller

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CERTIFICATE OF SERVICE

I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service as First-Class Mail in an envelope addressed to the correspondent of record:

Sandra Edelman, Esq.,
Dorsey & Whitney LLP
51 West 52nd Street
New York, New York 10019-6119

/s/ Michael A. Geller
Signature

Michael A. Geller
Name

May 11, 2016
Date of Signature

ANNEX A

CONFIRMATORY ASSIGNMENT

WHEREAS, THE PORT AUTHORITY OF NEW YORK AND NEW JERSEY, a body corporate and politic created by the States of New York and New Jersey with the consent of the Congress of the United States, having a place of business at One World Trade Center, New York, New York (hereinafter called "PORT AUTHORITY"), has adopted and used the service mark WORLD TRADE CENTER, for which it has obtained Argentine Service Mark Registrations 927594 and 937721 and the following New York State service mark registrations:

<u>Registration No.</u>	<u>Class</u>
S-9095	Advertising and Business Class 101
S-9096	Insurance and Financial Class 102
S-9097	Construction and Repair Class 103
S-9098	Communication Class 104
S-9099	Transportation & Storage Class 105
S-9100	Education & Entertainment Class 107

WHEREAS, the PORT AUTHORITY has sold and agreed to sell, transfer and convey to THE WORLD TRADE CENTERS ASSOCIATION, a Delaware corporation, having a place of business at One World Trade Center, New York, New York (hereinafter called "WTCA"), the entire right, title and interest in and to said service mark and said service mark registrations, together with the good will of its business in the services in respect of which the mark is used;


NOW, THEREFORE, for ten dollars (\$10.00) and other good and valuable consideration paid to PORT AUTHORITY by WTCA, the receipt and adequacy of which is hereby acknowledged:

PORT AUTHORITY has sold and does hereby sell, transfer and convey to WTCA, its successors, assigns and legal representatives, the entire right, title and interest in and to said service mark WORLD TRADE CENTER, said service mark registrations and the good will of PORT AUTHORITY's business in the services in respect of which the mark is used, together with all rights to apply for, obtain and hold registrations of the same and renewals and extensions thereof, and together with all right to bring suit for any past and future infringement of said mark. PORT AUTHORITY reserves to itself the right and license to use said service mark for the existing and future services.


This Assignment shall enure to the benefit of and be binding upon the parties hereto and their successors, assigns and legal representatives.

IN WITNESS WHEREOF, PORT AUTHORITY has caused this instrument to be executed as of this 18th day of February , 1986.

THE PORT AUTHORITY OF NEW YORK AND NEW JERSEY

By 
Doris E. Landre, Secretary

Sworn and subscribed to
before me this 19th day of
February , 1986.


Notary Public

HERBERT S. SOMERWITZ
Notary Public, State of New York
No. 310597
Qualified in New York County
Commission Expires March 30, 1986